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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,390	09/08/2000	Arthur J. Coury	FTI 126	3456

7590

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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 11/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,390

Applicant(s)

COURY ET AL.

Examiner

Michael A. Willis

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20 and 33-36, drawn to a polymer, classified in class 524, subclass 612.
 - II. Claim 37, drawn to a method of using a polymer, classified in class 524, subclass 612.
 - III. Claims 21-27, drawn to a compound AHK, classified in class 560, subclass 1.
 - IV. Claims 28-32, drawn to a compound AHC, classified in class 562, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions IV, III, and I are related as mutually exclusive species in an intermediate-2nd intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, each intermediate product is deemed to be useful as monomers in non-biocompatible polymers and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that

this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Inventions I, III, and IV are related to Invention II as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case methods of treating biological tissue or medical implants can be achieved with a variety of compositions and polymers outside the limitations of the polymer of Invention I and intermediates of Inventions III and IV.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Election of Species

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Upon the allowance of a generic claim, applicant will be

entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Invention I is generic to a plurality of disclosed patentably distinct species comprising polymeric hydrogels. Applicant is required under 35 U.S.C. 121 to elect a single disclosed polymer, even though this requirement is traversed. By species is meant a single polymer. The polymer may be identified in any of four ways: 1) according to the IUPAC standard, 2) by a pictorial representation, 3) by setting forth the specific chemical groups that form each monomeric unit and the connectivity between monomeric units, or 4) by naming an example which itself sets forth a single polymer.

8. Invention II is generic to a plurality of disclosed patentably distinct species comprising polymeric hydrogels. Applicant is required under 35 U.S.C. 121 to elect a single disclosed polymer, even though this requirement is traversed. By species is meant a single polymer. The polymer may be identified in any of four ways: 1) according

Art Unit: 1619

to the IUPAC standard, 2) by a pictorial representation, 3) by setting forth the specific chemical groups that form each monomeric unit and the connectivity between monomeric units, or 4) by naming an example which itself sets forth a single polymer.

9. Invention III is generic to a plurality of disclosed patentably distinct species comprising compounds of the formula AHK. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. By species is meant a single compound. The compound may be identified in any of four ways: 1) according to the IUPAC standard, 2) by a pictorial representation, 3) by setting forth the specific chemical groups that make up the units A, H, and K, or 4) by naming an example which itself sets forth a single compound of formula AHK.

10. Invention IV is generic to a plurality of disclosed patentably distinct species comprising compounds of the formula AHC. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. By species is meant a single compound. The compound may be identified in any of four ways: 1) according to the IUPAC standard, 2) by a pictorial representation, 3) by setting forth the specific chemical groups that make up the units A, H, and C, or 4) by naming an example which itself sets forth a single compound of formula AHC.

Conclusion

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention (group I, II, III, or IV) to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is further advised that a reply to

Art Unit: 1619


this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L. Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-2742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1619

November 16, 2001


MICHAEL G. HARTLEY
PRIMARY EXAMINER